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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,760	11/01/2001	Jay S. Walker	96-043-C2	5442
22927	7590	08/29/2006	EXAMINER CARLSON, JEFFREY D	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/998,760

Applicant(s)

WALKER ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: IDS docs filed 11/1/01, 1/4/02, 1/10/03.

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 11/1/01, a preliminary amendment amending the Cross Reference to Related Applications and canceling claims 4-85. Claims 1-3 are pending in this application.

### ***Information Disclosure Documents***

2. Examiner has considered applicant IDS documents filed 11/1/01, 1/4/02, and 1/10/03. The FR 2 757 656 A1 document has not been initialed because there is no English language portion(s) or translation.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant-admitted prior art.**
5. Applicant admits to the existence of prior art insofar as a telephone center has traditionally been known to allow consumers to call and request subscriptions [page 3 lines 15-17]. It would have been obvious to one of ordinary skill at the time of the invention to have called such a system inquiring about a particular magazine and to have received an offer to buy a subscription for that magazine using such a phone-

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based system. An obvious phone conversation with an agent on such a system would typically go like this:

1: [caller]                *I am interested in (buying) Sports Illustrated.*

2: [agent]                *A subscription to Sports Illustrated costs \$15 per year.*

3: [caller]                *I would like to buy such a subscription.*

Such a conversation including line 1 (above) is taken to read on a request to buy a single periodical. Note that applicant's disclosure focuses on the advantages of the invention's ability to offer a purchased *issue* of a periodical as the first *issue* of a subscription. In this case, applicant claim language provide no "issues", but merely a single periodical. The caller's initial request for Sports Illustrated is taken to provide a request to purchase a single periodical – Sports Illustrated. Such a purchased subscription would result in bookkeeping that documented the subsequent distribution to the customer of his first issue of Sports Illustrated as part of the subscription.

6. Regarding claim 2, Official Notice is taken that it is well known to provide phone operators with access to product information, pricing and order taking systems in order to provide convenient customer service and phone sales.


7. Regarding claim 3, Official Notice is taken that it is well known to accept credit card payments over the phone for products. It would have been obvious to one of ordinary skill at the time of the invention to have accepted credit card payments for such subscriptions ordered via telephone.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc